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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/798,300 | 03/12/2004 | Atsumi Kobayashi | D-1591 | 5790 |

7590 08/08/2005

KANESAKA AND TAKEUCHI

Suite 2

1423 Powhatan Street
Alexandria, VA 22314

EXAMINER

NICHOLSON III, LESLIE AUGUST

ART UNIT

PAPER NUMBER

3651

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/798,300 | KOBAYASHI, ATSUMI | |
| | Examiner | Art Unit | |
| | Leslie A. Nicholson III | 3651 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/12/2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/12/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a first office action on the merits of application 10/798300.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 24 (P13/L18), 31 (P14/L17), and 2 (P19/L6).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 83 (Fig.5).

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7,10, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 and 11 recite position of a document, however it is unclear by the way it is worded at what point the document is read (line 7 in each claim). It is suggested by the examiner to change each line to "and after the document is read" if this is what the applicant intends. The examiner will interpret the claims according to the suggested change.

Lines 7-22 of claim 1 recite function of structure, however it is unclear due to lack of punctuation what structure enables its respective function. For example, change line 7-10 from "transport means disposed adjacent to the sheet feeding means for receiving..." to "transport means, disposed adjacent to the sheet feeding means, for receiving...". Follow the same suggestion for the claim limitations in line 14-18 and 19-22 if this is what the applicant intends. The examiner will interpret the claims according to the suggested change. (see ¶12)

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1,2,3,4,7,10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rubscha USP 5,511,771.

Regarding claim 1, Rubscha discloses a similar document transport apparatus (10) for an image reading device (16) with a platen (12a) comprising:

- A sheet feeding tray (21), and a sheet discharging tray (22)
- Sheet feeding means (30)
- Transport means (40) disposed adjacent to the sheet feeding means (Fig.1)
- Sheet discharging means (50,53) disposed adjacent to the transport means (Fig.1)
- A switch back path (27) disposed adjacent to the sheet discharging means (Fig.1)
- A sheet discharging path (54) disposed adjacent to the sheet discharging means (Fig.1)

Regarding claim 2, Rubscha discloses a similar device comprising control means (100) electrically connected to the transport means and the sheet discharging means (C4/L40-51).

Regarding claim 3, Rubscha discloses a similar device wherein the discharging tray (22) is located below the sheet feeding tray (20) and above the platen (12a) (Fig.1)

Regarding claim 4, Rubscha discloses a similar device wherein the control means controls the transport means and the sheet discharging means (C4/L40-51).

Regarding claim 7, Rubscha discloses a similar device wherein the sheet discharging means include a pair of sheet discharging rollers (50,53) and the discharge path is located between the platen (12a) and the pair of sheet discharging rollers and branched from the switch back path (27) (Fig.1).

Regarding claim 10, Rubscha discloses a similar image reading apparatus (16) comprising a document transport apparatus (10), the platen (12a) for placing the document, and reading means (14) for reading the document placed on the platen.

Regarding claim 11, Rubscha discloses a similar device wherein the control means (100) controls the transport means and the sheet discharging means (C4/L40-51) (Fig.1).

7. Claim 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamesaki USP 5,754,934.

Regarding claim 8, Kamezaki discloses a similar document transport method comprising:

- drawing a document from a sheet feeding tray (10) (C13/L7-16)
- transporting the document to a predetermined position on a platen (4) (C13/L16-19) (Fig.4)

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- guiding the document after one side thereof is read to a switch back path (30,32,34,36), said switch back path turning the document upside down, reversing a leading end and a trailing end of the document and turning the document upside down again (C13/L29-31,L43-47) (Fig.4)
- transporting the document from the switch back path toward a sheet discharging tray (8) (C13/L43-47) (Fig.4)
- changing a transporting direction of the document before the document is completely discharged to the sheet discharging tray (C13/L43-47) (Fig.4)
- guiding the document that the transporting direction is changed to a U turn path to transport the document to the predetermined position on the platen again (C14/L8-12, L28-31) (Fig.4)
- transporting the document to the U turn path after the other side of the document is read, and (C14/L39-42) (Fig.4)
- discharging the document to the sheet discharging tray (C14/L39-42) (Fig.4)

8. Regarding claim 9, Kamezaki discloses all the limitations of the claim (see ¶7) and further discloses a method comprising:

- guiding the document after one side thereof is read to a U turn path to thereby transport the document toward a sheet discharging tray (C13/L29-31,L43-47) (Fig.4)
- changing a document transfer direction before the document is completely discharged to the sheet discharging tray (C13/L43-47) (Fig.4)

- guiding the document to a switch back path, said switch back path turning the document upside down, reversing a leading end and a trailing end of the document and turning the document upside down again (C13/L29-31, L43-47) (Fig.4)
- transporting the document from the switch back path to a predetermined position on the platen (C14/L8-12, L28-31) (Fig.4)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubscha USP 5,511,771 in view of Honjo USP 4,817,933.

Rubscha discloses all the limitations of the claim (see ¶6) but does not disclose the apparatus further comprising a guide member disposed at a discharge side of the platen.

Honjo teaches a guide member (23) disposed at a discharge side of the platen (12) for the purpose of securely guiding a document discharged from the platen (C7/L12-23).

At the time of invention it would have been obvious to one having ordinary skill in the art to have used a guide member disposed at a discharge side of the platen, as

taught by Honjo, in the device of Rubscha, for the purpose of securely guiding a document discharged from a platen.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubscha USP 5,511,771 in view of Honjo USP 4,817,933 and in further view of Yano USP 6,467,767.

Rubscha discloses all the limitations of the claim (see ¶6) but does not disclose the apparatus wherein the switching means includes a torque limiter disposed on a driving shaft of a transporting roller.

Yano teaches a torque limiter disposed on a driving shaft of a transporting roller for the purpose of transmitting a driving force of predetermined torque to the roller (C14/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to have used a torque limiter disposed on a driving shaft of a transporting roller, as taught by Yano, in the device of Rubscha, for the purpose of transmitting a driving force of predetermined torque to the roller

Examiner's Note

12. The claim is interpreted as not invoking 35 USC 112 6th ¶ since it has not been officially noted in the specification as doing so.


Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GENE O. CRAWFORD
PRIMARY EXAMINER

L.N.
8/5/2005